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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,488	09/29/2003	Frederic Pialot	033818-009	8468
21839	7590	08/08/2006	EXAMINER	
BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			KNABLE, GEOFFREY L	
			ART UNIT	PAPER NUMBER

1733

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

Office Action Summary	Application No. 10/671,488	Applicant(s) PIALOT, FREDERIC	
	Examiner Geoffrey L. Knable	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Cancellation of claims directed to the non-elected grouping is taken as affirmation of the prior election.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 12-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In new claim 12, in the last two lines of step (b), reference is made to the subsequently deposited layer having "at least a portion thereof projecting beyond a periphery of a previously deposited layer" - it however is not seen where the original disclosure describes the invention in this manner or esp. to this scope (esp. "at least a portion...") and as such, this is considered to be subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter. While the original disclosure does show a subsequent layer that at least in cross-section projects beyond the underlying layer and further the original disclosure expressly describes covering the entire surface (e.g. original claim 4), it is not considered that the original disclosure reasonably describes what is now claimed. As only one example, the present language is inclusive of a subsequently deposited layer that is smaller and within the periphery of

Art Unit: 1733

the underlying layer in all areas except one small projection - it however is not considered that the original disclosure reasonably evidences possession of such.

4. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, reference is made to "uncured colored rubber" whereas in claims 13 and 14, reference is made to "non-vulcanized colored" rubber - as it seems that these are intended to be referring to the same material, it is suggested that consistent terminology be adopted to avoid confusion created by use of different terms for the apparently same material.

5. Claims 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makinson et al. (US 5,653,840) taken in view of at least one of [Bohm et al. (US 5,296,077) and DE 3046572 to Continental] and further in view of Williams et al. (US 2,985,216).

These references are applied for substantially the same reasons as set forth in the last office action. As to the requirement that the subsequently deposited layer have at least a portion projecting beyond the underlying layer, it is noted that Williams suggests it to be desirable to provide the motif/indicia in the form of plural layers with beveled margins so as to outline the indicia in contrasting colors, thereby easing reading and enabling unique identification (esp. col. 3, lines 19-30). In view of these teachings, it is considered to have been obvious to provide indicia formed as in the primary reference with subsequently applied layers (which will form the inner layers in

the final tire) that project beyond the underlying layers so as to provide the advantageous outlining in contrasting colors. Claims 13-16 and 18 are rejected for the same reasons set forth with respect to the corresponding claims in the prior action. As to claim 17, it is considered to have been well known, conventional and obvious to form plural indicia on a single tire sidewall.

6. Applicant's arguments filed May 12, 2006 have been fully considered but they are not persuasive.

With respect to the Williams reference, applicant has stressed that this reference is applying to an already formed tire - while this is not disputed, it is still considered that the teachings of the advantages from providing plural colored layers where the underlying layers project to provide a border would have been seen to be applicable to indicia formed in any manner - in other words, it is considered that the ordinary artisan would have understood that the advantages attaching to having outlined indicia do not depend upon how the indicia is formed and thus such advantages would have been expected to apply to any tire indicia formed in any manner including as in the primary reference.

It is also noted that applicant mentions the two layers suggested in Bohm (US 5,296,077) - in addition to the distinctions noted by applicant, it is also pointed out that in the fig. 16 embodiment, although the rubber is of smaller size than the cavity, it is expressed described than the volumes are equal (col. 9, lines 43-45), contrary to the present claims. The other teachings for which this reference was used are however still considered to be properly applicable for the reason given in the last office action.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
August 5, 2006